THE SECTION 112 REJECTION

In response to the Rejection, Applicant has amended the language of claim 1 and submits that the amendment overcomes the Section 112 rejection. The processor and server are shown on FIG. 1 and on page 5, lines 11-26 of the instant specification. The network based community of IP users is supported by page 9, line 20 of the instant specification. The specification on page 13, lines 10-27 teaches that the software that guides a user through each step of preparing an application for an IP asset to reduce preparation cost and a server to accept a request from the user to a network based community of IP users including patent attorneys to perform value-added pre-filing check to enhance the application quality, wherein the server provides the user access to a market-based system with fee negotiation for getting qualified IP assistance. The specification also teaches on page 16, line 24-page 17 line 6 that the system supports collaborations between the user and the IP expert. The amendment on claim 26 is supported by pages 7-8 of the specification. Withdrawal of the Section 112 rejection is requested.

THE SECTION 103 REJECTION

The Office Action noted that all claims are unpatentable over Riordan and Official Notice.

Applicant respectfully traverses the rejection. Here, the rejection is improper since the prior art reference relied upon by the examiner in a § 103 rejection does not contain every element recited in the claim in as complete detail as is contained in the claim and arranged as recited in the claim. Nowhere in Riodan does it show the claimed specifics of a system with software that guides a user in preparing a patent application for an IP asset to reduce preparation cost. Further, the references do not teach or suggest a server coupled to the processor over a network, the server accepting a request from the user to a network based community of IP experts including patent attorneys to perform value-added pre-filing check to enhance the application quality prepared by the user, wherein

the user accesses a market-based system for fee negotiation to get qualified IP assistance and wherein the server supports collaborations between the user and the IP expert in drafting the patent application. In the instant case, the Examiner has not provided any rationale or evidence in the reference proving that Riodan shows the processor and the database. Withdrawal of all rejections is requested.

Here, the suggestion arises from hindsight as taught by the instant application. Per MPEP 706.02(j): Contents of a 35 U.S.C. 103 Rejection:

> To establish a prima facie case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art and not based on applicant's disclosure. In re Vaeck, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). See MPEP Section 2143 - Section 2143.03 for decisions pertinent to each of these criteria.

> The initial burden is on the examiner to provide some suggestion of the desirability of doing what the inventor has done. "To support the conclusion that the claimed invention is directed to obvious subject matter, either the references must expressly or impliedly suggest the claimed invention or the examiner must present a convincing line of reasoning as to why the artisan would have found the claimed invention to have been obvious in light of the teachings of the references." Ex parte Clapp, 227 USPQ 972, 973 (Bd. Pat. App. & Inter. 1985). See MPEP Section 2144 - Section 2144.09 for examples of reasoning supporting obviousness rejections.

As discussed above, there is no suggestion to modify Riodan to arrive at the invention as claimed. There is no reasonable expectation of success since Riodan does not even address patent generation by users who can tap into a network of IP experts who can help the user complete the patent application. Finally, Riodan, does not teach or suggest all the claim limitations in the independent claims as well as each dependent claims. Since the teaching or suggestion to make the claimed combination and the reasonable expectation of success is not found in Riodan, there is an inference that it

came from Applicants' disclosure. Thus, Riodan cannot render obvious the independent claim and those claims dependent therefrom.

Additionally, the details in the dependent claims are not taught or suggested by Riordan and Official Notice. Here, dependent claims are allowable since Riodan does not show the specifics as recited in the dependent claims as follows:

As for claim 16, Riodan fails to show the claimed online platform for selling and buying patentable ideas or pending patent applications.

As for claim 17, Riodan fails to show the claimed parties can list and search for applications that are within a predetermined period from abandonment.

As for claim 18, Riodan fails to show claim 1 where the network is the Internet and wherein clients access the system using a browser.

As for claim 19, Riodan fails to show the claimed a patent information management (PIM) system to display information for a user to manage the user's IP and to communicate with other users relating to the IP.

As for claim 20, Riodan fails to show that the PIM provides information on pending activities relating to an IP asset and wherein the user drills down to get additional information on the IP asset.

As for claim 21, Riodan fails to show that the PIM permits sellers to list assets for sale, buyers to bid on assets of interest and users to browse through listed items in a fully-automated, topically-arranged, intuitive and easy-to-use online service.

As for claim 22, Riodan fails to show that the PIM provides real time and interactive auctions that allows bidders place bids in real time and compete with other bidders using the Internet.

As for claim 23, Riodan fails to show that the PIM allows customer bids to be automatically increased up to a maximum amount so bids can be raised and auctions won even when bidders are away from their computers.

As for claim 24, Riodan fails to show that the PIM provides the user with access to a social network.

As for claim 25, Riodan fails to show that the PIM provides the user with access to a network of IP lawyers for assistance in finalizing the applications, specialists for trading IP, venture capitalists and financiers.

As for claim 26, Riodan fails to show appraising the IP asset by considering duration of rights; status of applications made in foreign countries; litigation with third parties; licensing status; technical nature of the IP; related patents; technical dominance of the IP asset, extent and clarity of specification; clarity of range of technology; relationship to use of IP rights possessed by third party; technical superiority to substitute technology; proven by real use; necessity of additional development for commercialization; markets for commercialization; transfer and distribution potential; inventors (or right-holders)'s intent to engage in continual research and development and the possibility of applying the results; limits on the term and region of implementation; ability to exercise rights against infringing parties; possibility that rights will be invalidated, canceled, or limited; substitute technology; manufacturing ease of imitation product; ease of detecting infringing products; size of the market, market scale, market share that is acquirable and time frame for acquiring the targeted market share; life span for the product's market; price that a customer is willing to pay; and sustainability of the profit.

As for claim 27, Riodan fails to show that the PIM allows an inventor to file a patent application with a patent office.

As for claim 28, Riodan fails to show that the PIM allows an inventor to file a patent application.

As for claim 29, Riodan fails to show that the PIM automatically updates the user on any new IP in the user's areas of interest.

As for claim 30, Riodan fails to show that the PIM provides an appraisal of the IP.

As for claim 31, Riodan fails to show that the PIM provides escrow to facilitate an IP transaction.

As for claim 32, Riodan fails to show that the PIM provides a virtual showroom which displays the IPs offered for sale and enables a potential

purchaser or customer to view the IP asset, view rating information regarding the IP asset or place a bid to purchase the IP asset.

As for claim 33, Riodan fails to show that the PIM accesses one or more search engines that continuously search the web and identify information that is of interest to the user.

As for claim 34, Riodan fails to show that the PIM supports user-generated IP content.

Appellant points out that the Examiner bears the initial burden of factually establishing and supporting any *prima facie* conclusion of obviousness. *In re Rinehart*, 189 U.S.P.Q. 143 (CCPA 1976); M.P.E.P. § 2142. If the Examiner does not produce a *prima facie* case, the Applicant is under no obligation to submit evidence of nonobviousness. *Id.* In the instant case, the Examiner has not pointed to any evidence in Riodan, or how knowledge of those skilled in the art, provide a suggestion or motivation to modify the reference teaching so as to produce the claimed invention of independent claim 1. See *In re Zurko*, 59 U.S.P.Q.2d 1693 (Fed. Cir. 2001) ([I]n a determination of patentability …. the Board cannot simply reach conclusions based on its understanding or experience - or on its assessment of what would be basic knowledge or common sense. Rather, the Board must point to some concrete evidence in the record in support of these findings).

Under *Vaeck*, absent any evidence of a cited suggestion or reasonable motivation in the Marsh reference, or knowledge of those skilled in the art, for modifying Riodan to arrive at claims 1 and those dependent therefrom, *prima facie* obviousness of these claims has not been established. As such, it is respectfully requested that the § 103(a) rejection of all claims be withdrawn and the claims be allowed.

CONCLUSION

In view of the foregoing, Applicants believe all claims now pending in this Application are in condition for allowance. The issuance of a formal Notice of Allowance at an early date is respectfully requested.

If the Examiner believes a telephone conference would expedite prosecution of this application, please telephone the undersigned at 408-528-7490.

Respectfully submitted,

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